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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,826	10/28/2005	Oystein Ljungmann	027064-004	8640

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BUCHANAN, INGERSOLL & ROONEY PC
POST OFFICE BOX 1404
ALEXANDRIA, VA 22313-1404

EXAMINER	
LEVKOVICH, NATALIA A	
ART UNIT	PAPER NUMBER
1797	

NOTIFICATION DATE	DELIVERY MODE
11/30/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

Office Action Summary	Application No.	Applicant(s)	
	10/537,826	LJUNGMANN ET AL.	
	Examiner	Art Unit	
	NATALIA LEVKOVICH	1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06/26/2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _____ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Applicant's amendments and remarks filed on 06/26/2009 have been acknowledged.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

Drawings

3. The previous objection to the drawings has been withdrawn in view of the latest amendments and clarifications provided by the Applicant.

Claim Rejections - 35 USC § 112

4. Claim 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being unclear for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants' efforts to clarify the claim language have been appreciated. On the other hand, some changes to the claims raised new clarity issues. With respect to claim 1, the row(s) 'extending from the 'first end of the staining machine to an opposite end of the …row', is not clear. Examiner assumes that 'extending from the 'first end of the staining machine to the second end of the staining machine', was rather intended. It is also unclear what structural features of the transport devices would provide for the simultaneous transport of the baskets. The claim was also amended to recite the baskets being transported 'in

accordance with a predetermined treatment program'. It is unclear whether or not any controller is intended.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tabata (US 4911098 in view of Ljungmann et al. (US 6436348).

With respect to claims 1-4, Tabata discloses an apparatus for staining tissue specimen slides comprising, as shown in Figures 6-7, one or two rows of baths 1-23 and at least two robots 21-22 ["devices for transport / transfer of baskets"]. Figure 7 illustrates a transport / transfer device configured for transferring baskets between the rows ["crossbar device"]. Each robot includes a clamp member 8 with a pair of plates 13 ["cheeks extending along the bath rows"] and a vertical driving mechanism including motor 27 ["device for lifting and

lowering the cheek pair"] coupled to feed screw 26 via a belt [one of the two "toothed belts", not shown]. Figure 3 also shows the clamp member 8 having belt 15 [another "toothed belt" running "in a closed path"] having an upper and lower guide wheels [not indexed] and driven by motor 20.

Tabata does not teach the baskets being transported 'in accordance with a predetermined treatment program. However, the invention of Tabata is drawn to increasing the level of automation of the staining process. Ljungmann et al. disclose a staining apparatus comprising a plurality of stations' in the form of vessels having liquid baths for receiving baskets', transportation means controlled in accordance with a chosen treatment program (Abstract).

Tabata also teaches that, since the time factor is important for the specimen preparation, 'a software-wise possibility to optimalize coordination of the different programs', in order to 'find the most efficient running scheme for the movements of the transport means in order to be able to prepare as many baskets as possible in compliance with the different chosen programs in the shortest possible time', would be advantageous for the invented apparatus (Col, 2, lines 53-65). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the apparatus of Tabata by providing a software based control over the transport means, in order to reduce the processing time.

Additionally, regarding claims 1-2, as was noted previously with respect to the input and output stations, since these features are not positively recited as a part of the claimed invention, they are not accorded any patentable weight.

Regarding claim 4, although Tabata, as discussed above, teaches the staining machine to comprise motors, the stepper motors are not specifically disclosed. However, these motors are routinely employed in the art when a full rotation of a motor needs to be divided into a large number of steps, to provide a controlled motion for a driven object, for example, for the staining process. it would have been within the ordinary skill of an artisan at the time the invention was made to have employed stepper motors in the modified the apparatus of Tabata, in order to provide controlled transportation for the baskets.

Regarding claims 6 and 7, the devices for the transport / transfer of baskets can include, as shown in Figures 7-8, a "crossbar bracket" 4 attached to a slide block [not indexed] and adapted for "releasable connection" with basket 2, and further coupled to motor(s) via belts (discussed above), for reciprocating movement of the crossbar bracket in a horizontal direction(as indicated by the horizontal arrow in Figure 7) ,along two horizontal guide rods [not indexed].

Allowable Subject Matter

8. Claim 5 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The closest prior art, Tabata, does not teach, or fairly suggest a staining machine having the structure set forth in claim 4, and further comprising the pair of toothed belts of the lifting and lowering device, arranged at one end of

the staining machine, being coupled to a corresponding pair of toothed belts arranged at the opposite end of the machine, as recited in the instant claim 5.

Response to Arguments

9. Applicant's arguments filed 06/26/2009 have been fully considered but they are not persuasive, or moot in view of the new grounds of rejection.

Applicant argues that Figures 7-8 show conventional apparatuses, known prior to the invention of the Tabata, and that, 'in fact, Tabata explains at some length the drawbacks and disadvantages of said conventional apparatus as set forth in Col. 2, lines 22-68, thus teaching against the combination of apparatus proposed by the Examiner'. Examiner disagrees and notes that disclosed preferred embodiments do not constitute a teaching away from non-preferred embodiments, including those prior known in the art.

Applicant further argues that 'Tabata does not disclose a staining machine comprising a device for the transfer of baskets from a bath at the opposite end of the first bath row to a bath at the opposite end of the second bath row'. Examiner disagrees. The device shown in Figure 7, is clearly capable to transfer the baskets in this manner. See also the art rejection above.

Applicant further argues that 'Tabata fails to disclose a first bath row extending from an input station located at a first end of the staining machine to an opposite end of the first bath row and a second bath row extending from an output station located at the first end of the staining machine to an opposite end

of the second bath row, as recited in claim 1. Rather, Tabata discloses a loading port 6 on one end and a discharge port 7 on the other end. Hence, Tabata does not disclose an input station at a first end and an output station also at the first end of the straining machine'. Examiner maintains that the input and output stations are not positively recited as a part of the claimed invention, and, therefore, they are not accorded any patentable weight.

Applicant further argues that 'Tabata also fails to disclose a first transport device for successive and simultaneous transport of the baskets' from one end of the rows to another, and that ,'as explained in Tabata at Col. 9, lines 32-40, first robot 21 moves from the loading zone 6 to relay station 19 and second robot 22 moves from the relay station 19 to the discharge port 7. Hence, neither robot moves from one end of the row to the other end of the row'. Examiner disagrees. First, the transport devices 21, 22 of Figure 6 in Tabata, are shown as capable of transporting the baskets successively and simultaneously. Second, the devices can be moved along the entire length of the row, depending on a particular protocol for the staining procedures.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalia Levkovich whose telephone number is 571-272-2462. The examiner can normally be reached on Mon-Fri, 2 p.m.-10 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jill Warden/
Supervisory Patent Examiner, Art Unit 1797